# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/603,999 | 06/25/2003 | Sean E. Aschen | END920030038US1 | 4751 |

| | | | EXAMINER |
|---|---|---|---|
| 26502 | 7590 | 12/29/2005 | ONI, OLUBUSOLA |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2168 | |

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/603,999 | ASCHEN ET AL. |
| | Examiner | Art Unit | |
| | OLUBUSOLA ONI | 2168 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>25 June 2003</u>.

2a)☐ This action is **FINAL**.      2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>06/25/2003</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

1.      This action is responsive to communication: Application, filed on

06/25/2003

### Claim Objections

Page 1 of the specification is objected to because serial number for related

application is missing. Examiner suggests that applicant fix this error.

### *Claim Rejections - 35 USC § 103*

1.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.      Claim 1-6 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Benninghoff III (Pub No U.S 2002/0091782) hereinafter "Benninghoff" in the view

of Don Box et al. (W3C Copyright 2000) hereinafter " Don"

As per claim1, Benninghoff teaches "Providing a file of documents having fields"

(See paragraph [0012], [0134] and Fig 2-3 & 7);

" receiving a request for one or more of said fields of one of said documents  from as a

message in a simple access protocol from an application" (See paragraph [0134] and

Fig 5 & 19)

"extracting said one or more of said fields from said file as an extended mark up

document" (See paragraph [0010-0012] and [134]);

"parsing said extended markup document according to schema" (See paragraph [0009-

0011])

"authenticating said application" (See paragraph [0014],[0043],[0046] and Fig 5 &12)


Benninghoff does not explicitly teach "the method of receiving a request for one or

more of said fields of one of said documents as a message in a simple object access

protocol".

        However, Don teaches "receiving a request for one or more of said fields of one

of said documents as a message in a simple object access protocol" (See [1-4])

It would have been obvious to one of ordinary skill in the art at the time of the invention

to have combined the two references because using Don's teachings would enhance

the receiving of a request for the fields of documents to be made as a message in a

simple access protocol.


Benninghoff does not explicitly teach " sending the parsed document as a simple object

access protocol message to said application"

However, Don teaches "sending the parsed document as a simple object access protocol message to said application" (See [1-4])

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the aforementioned references because using Don's teachings would have given those skilled in the art a tool for sending XML documents as a simple object access protocol message.

As per claim 2, this claim is rejected on the grounds corresponding to the argument given above for rejected claim 1 above including the following reasons: Benninghoff does not explicitly teach " wherein said simple object access protocol is SOAP 1.1".

However, Don teaches "wherein said simple object access protocol is SOAP 1.1" (See paragraph [1.1-9])

As per claim 3, this claim is rejected on the grounds corresponding to the argument given above for rejected claim 1 above including the following reasons: Benninghoff teaches "wherein said extended markup document is an XML document" (See paragraph [0010-0012] and [0134])

As per claim 4-5, this claim is rejected on the grounds corresponding to the argument given above for rejected claim 1 above including the following reasons:

<u>Don</u> teaches " wherein said schema is formatted according to document content and

document type definition"(See [3-5])


As per claim 6, this claim is rejected on the grounds corresponding to the

argument given above for rejected claim 1 above including the following reasons:

<u>Benninghoff</u> teaches " wherein said application is authenticated by ..."(See paragraph

[0014], [0043], [0046], [0046], [0055], [0131] and Fig 5& 12)


As per claim 16 <u>Benninghoff</u> teaches "a file having data stored as documents"

(See Paragraph [0012] and [0134] and Fig 2-3 & 7)

"a database for passing a request for one of said documents to said file and upon return

converting said one of said documents ..." (See paragraph[0010 - 0012],[0134] and Fig

5, 11 &19);

" an authentication directory having authentication records for an application" (See

paragraph [0014], [0043], [0046], [0055], [0131] and Fig 5 & 12)

" web service software for receiving a request from an application for one of said

documents, retrieving said one of said documents" (See paragraph [0134]), and Fig 5 &

19) "creating an extended markup object containing said document (See paragraph

[0010-0012],[0134] and Fig 5 & 11);

" and a protocol tool for authenticating said application using said records" (See

paragraph [0014], [0043], [0046], [0055], [0131] and Fig 5 & 12])

Benninghoff does not explicitly teach "sending the marshaled object in a simple object

access protocol to said application"

However, Don teaches "sending the marshaled object in a simple object access

protocol to said application" (See [1-4])

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have modified Benninghoff by the teachings of Don, to send objects in a

SOAP messages to the application because, Soap provides a simple and lightweight

mechanism for exchanging structured and typed information in decentralized,

distributed environment.


As per claim 17, this claim is rejected on the grounds corresponding to the

argument given above for rejected claim 16 above including the following reasons:

Benninghoff teaches " Wherein said software and said tools are adapted to operate

without the need for a mail or calendaring client" (See paragraph [0009] and Fig 1)


As per claim 18, this claim is rejected on the grounds corresponding to the

argument given above for rejected claim 16 above including the following reasons:

Benninghoff teaches " wherein said extended markup format is XML" (See paragraph

[0010-0012] and [0134])


As per claim 19, this claim is rejected on the grounds corresponding to the

argument given above for rejected claim 16 above including the following reasons:

Benninghoff does not explicitly teach " wherein object is marshaled into simple object

protocol according to a pre-defined set of rules"

However Don teaches " wherein object is marshaled into simple object protocol

according to a pre-defined set of rules"(See [1-5])


As per claim 20, this claim is rejected on grounds corresponding to the

arguments given above for rejected claims 16 and 19 is similarly rejected.


3.      Claim 7-10, 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Benninghoff III (Pub No U.S 2002/0091782) hereinafter "Benninghoff" and Don Box

et al. (W3C Copyright 2000) hereinafter " Don" and further in the view of Grout (Pub No

U.S 5,913,033) hereinafter "Grout"


As per claim 7, Benninghoff teaches " providing a mail file for documents having

..." (See paragraph [0012], [0134] and Fig 2,3 & 7)

"receive a request as a SOAP Protocol message from an application for one of said

documents" (See paragraph [0134] and Fig 5 & 19);

"retrieving said fields of said one of said documents from said mailfile" (See paragraph

[0134] and Fig 5,11);

"in response to said fields, retrieving said one of said documents as a markup language

document" (See paragraph [010-012] and [0134]);

Benninghoff does not explicitly teach "inserting a URL into said markup language

document to retrieve said..."

" retrieving said section from said mailfile in said markup language"

"removing said URL from the retrieved document and creating an object having said

section expanded in the retrieved document"

However, Grout teaches ""inserting a URL into said markup language document to

retrieve said section of said one of said document" (See [Col 3, lines 13-32], [Col 6,

lines 60-633] and Fig 2A);

" retrieving said section from said mailfile in said markup language" (See [Col 3, lines

13-32] and Fig 2A);

"removing said URL from the retrieved document and creating an object having said

section expanded in the retrieved document" (See [Col 5, lines 45-61] and Fig 2A])

        At the time of the present invention, it would have been obvious to one of

ordinary skill in the art to combine the two references because Grout's method of

inserting a URL and retrieving the designated section to replace the URL would have

enabled Benninghoff's method of providing data to an application to increase the

performance of browsing documents and allows downloading of multimedia objects

tailored for the user's language or culture (See [Col 2, lines 59-64])


Benninghoff and Grout do not explicitly teach "receiving a request as a SOAP protocol

message from an application for one of said documents"

"sending marshaled objects to said application as a SOAP protocol message"

However, <u>Don</u> teaches "receiving a request as a SOAP protocol message from an application for one of said documents" (See paragraph [1.3-4])

It would have been obvious to one of ordinary skill in the art at the time of the invention because combining the aforementioned references with Don's teachings would have given those skilled in the art a tool for receiving request and sending objects as a SOAP message because, Soap provides a simple and lightweight mechanism for exchanging structured and typed information in decentralized, distributed environment.

As per claim 8, this claim is rejected on the grounds corresponding to the argument given above for rejected claim 7 above including the following reasons: <u>Benninghoff</u> teaches "wherein said fields are retrieved as a XML document"(See paragraph [0010-0012] and [0134])

As per claim 9, this claim is rejected on the grounds corresponding to the argument given above for rejected claim 7 above including the following reasons <u>Grout</u> teaches " wherein said markup language is HTML or XHTML" (See [Col 5, lines 45-61] and [Col 6, lines 60- Col 7, lines 45])

As per claim 10, this claim is rejected on the grounds corresponding to the argument given above for rejected claim 7 above including the following reasons: <u>Benninghoff</u> teaches " wherein said one of said documents has a file attachment into object"(See Fig 3-4 &7)

As per claim 12, this claim is rejected on the grounds corresponding to the argument given above for rejected claim 7 above including the following reasons <u>Grout</u> teaches " said one of said document has an image tag"(See [Col 7, lines 1-44]).

As per claim 13, this claim is rejected on the grounds corresponding to the argument given above for rejected claim 12 above including the following reasons <u>Grout</u> teaches "retrieving the image tag, encoding said image tag and inserting..." (See [Col 6, lines 60 - Col 7, lines 45] and Fig 2A).

As per claim 14, this claim is rejected on the grounds corresponding to the argument given above for rejected claim 7 above including the following reasons <u>Grout</u> teaches "said one of said documents has a link to other items in said document" (See [Col 3, lines 13-32] and Fig 2A)

As per claim 15, this claim is rejected on the grounds corresponding to the argument given above for rejected claim 14 above including the following reasons <u>Grout</u> teaches " retrieving the content of said link, and inserting said content in the retrieved document at the position of said link" (See [Col 6, lines 60- Col 7, line 45] and Fig 2A)

4.      Claim 11, is rejected under 35 U.S.C. 103(a) as being unpatentable over

Benninghoff, Don and Grout, as applied to claim 4 above, and further in the view of

Little et al. (Pub No. US 2005/0114671) hereinafter Little

As per claim 11, this claim is rejected on the grounds corresponding to the

argument given above for rejecting claim 10 above including the following reasons:

Benninghoff, Don and Grout do not explicitly teach "retrieving attachment,

removing said link, and inserting said attachment into said object".

However, Little teaches "retrieving attachment, removing said link, and inserting

said attachment into said object"(See paragraph [0076])

It would have been obvious to one of ordinary skill in the art at the time of the

invention to combine the aforementioned references because Little's method of

embedding the attachment into the body of the email messages would have enabled

Benninghoff and Grout's method of providing data to an application to save user's effort

and time needed to open and store the attachment, by already displaying the

attachment within the body of the email message.

## CONCLUSION

5.      The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. US# 6,424,995, 6,859,213, 20030120737, 20020133633,

20040183830, 20030131142, 20050246415

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to OLUBUSOLA ONI whose telephone number is 571-272-

2738. The examiner can normally be reached on 7.30-5.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, JEFFERY GAFFIN can be reached on 571-272-4146. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

OLUBUSOLA ONI
Examiner
Art Unit 2168